

REMARKS

Upon entry of the aforementioned amendments, claims 1-6 and 8-17 will be pending in the application.

Applicants request reconsideration of the final Office Action based upon the following comments.

Claim Rejections-35 U.S.C. § 103

The Office Action set forth the following obviousness rejections:

- 1) claims 1-4, 7-10, and 14 are rejected in view of Watanabe (US 5,127,074) and Mugiya (US 5,841,924); and
- 2) claims 5, 6, and 11-13 are rejected in view of Watanabe '074, Mugiya, and Watanabe (US 5,661,834).

Applicants respectfully traverse these rejections and request that they be withdrawn.

Claim 1 sets forth that the invention has “said first end portion being bonded to said contacting surface of said mounting member” and “a lens held by said first member, said lens provided between said optical fiber and said optical semiconductor element.”

Watanabe fails to depict the invention set forth in claim 1. The first tubular member (asserted by the Examiner to be part 12a) of Watanabe is not bonded to the surface of the mounting member (asserted by the Examiner to be part 32). Part 12a of Watanabe is not bonded to part 32. Rather, part 12a of Watanabe is bonded to parts 14 and 12b.

Applicants also wish to indicate that even if the Examiner asserts that part 14 is equivalent to first tubular member, there still would be a structural difference. Part 14 of Watanabe does not support the lens part 22.

Furthermore, consideration of Mugiya does not alleviate the failings of Watanabe. Part 14 of Mugiya connects to part 13a. There is no connection between part 16, which holds the lens 15, and part 13a of Mugiya.

Hence, claim 1 and dependent claims 2, 4-6, 8-16 are not obvious in view of the cited prior art. Both of the cited patents fail to disclose the structure recited in independent claim 1.

Applicants also urge that independent claim 3 (equivalent to original claims 1, 2, and 3), which covers the second embodiment detailed in the application, is not obvious in view of the cited prior art patents. The cited prior art patents fail to teach or suggest "a third member having a tubular portion and a pair of openings, said tubular portion extending in a direction of the predetermined axis and accommodating said second member and said ferrule". The third member of Watanabe (Applicants respectfully submit that part 14 is the first member, part 12a is the second member, and part 12b is the third member) does not accommodate the second member and the ferrule. Likewise, the third member of Mugiya (Applicants respectfully submit that part 14 is the first member, part 16 is the second member, and part 17 is the third member) has similar failings.

The cited prior art fails to teach, hint, or suggest the claimed invention to one of ordinary skill in the art.

New Claims

New claims 15-17 have been added to the application. Claims 15 and 16 are allowable based on their dependency from independent claim 1.

Applicants have also added new independent claim 17 to the application. This claim recites the following allowable features:

“said first member is in communication with said mounting member”, and
“said first end portion having a smaller diameter than said mounting member”.

The cited prior art fails to disclose or suggest these features. The first member of Watanabe (part 14) has a larger diameter than the mounting member (part 32). Likewise, the first member of Mugiya (part 14) has a larger diameter than the mounting member (part 13a).

Applicants note that the Office Action sets forth that “it would have been obvious at the time the invention was made to a person having ordinarily skill in the art to have altered the outer edge of a first portion to be located inside the edge of the mounting member for the purpose of acquiring the most optimal fit of the semiconductor module in a applications as well as downsizing the first member.” However, the disclosure of the cited prior art patents fail to support this assertion. Both of the prior art patents show that the first member (that is in communication with the mounting member) has a larger diameter than the mounting member. The parts referenced in the Office Action as the first member are separated from the mounting member.

CONCLUSION

Applicants respectfully submit that this response obviates the rejections detailed in the Office Action and that this application should be allowed.

If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

Date: December 8, 2003 Signature:


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